

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

DAHIYAT *et al.*

Serial No. 10/666,311

Filing Date: September 18, 2003

For: *Protein Design Automation for Protein
Libraries*

Examiner: BORIN, Michael L.

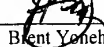
Art Unit: 1631

Confirmation No. 8879

CERTIFICATE OF ELECTRONIC TRANSMISSION

I hereby certify that this correspondence, including listed enclosures, is being electronically transmitted in Portable Document Form (PDF) through EFS-Web via Hyper Text Transfer Protocol to the United States Patent and Trademark Office's Patent Electronic Business Center on:

Date: September 29, 2006

Signature 
Brent Yonehara

TERMINAL DISCLAIMER TO
OBVIATE DOUBLE PATENTING REJECTION

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Petitioner, **Xencor, Inc.** (hereinafter "XENCOR"), represents that it is the assignee of the entire right, title, and interest of:

1. The instant application, U.S. Serial No. 10/666,311, filed September 18, 2003; and
2. U.S. Patent No. 6,403,312, filed October 15, 1999.

An assignment is recorded in the United States Patent and Trademark Office for U.S. Patent No. 6,403,312, at Reel No. 011517, Frame No. 0330. A copy of this assignment is attached hereto.

XENCOR hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. §§ 154-156 and 173, as shortened by any terminal disclaimer of U.S. Patent No. 6,403,312.

XENCOR hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This

Serial No.: 10/666,311
Filed: September 18, 2003

agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, XENCOR does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. §§ 154-156 and 173 of U.S. Patent No. 6,403,312, as shortened by any terminal disclaimer, in the event that the patent later expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. § 1.321, has all claims cancelled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as shortened by any terminal disclaimer.

The undersigned is empowered to act on behalf of the petitioner/assignee. The undersigned has reviewed the evidentiary documents in the chain of title of the present application identified above, and certifies that, to the best of assignee's knowledge and belief, title is in the assignee XENCOR.

While Applicants believe that no other fees are due at this time, the Commissioner is authorized to charge the terminal disclaimer fee of \$65.00 under 37 C.F.R. 1.20(d), and any additional fees or any other relief that may be required, in connection with this reply to Deposit Account 50-2319 (Order No. 463077-00244; Docket No.: A-67229-12).

The undersigned is an attorney or agent of record.

DORSEY & WHITNEY LLP

Dated:

Sept 29, 2006

By:



Customer No.: 32940

555 California Street, Suite 1000
San Francisco, CA 94104-1513
Telephone: (415) 781-1989
Facsimile: (415) 398-3249

Timothy A. Worrall, Reg. No. 54,552 for
Robin M. Silva, Reg. No. 38,304

Attorneys of Record for Applicant



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APRIL 30, 2001

PTAS

FLEHR HOHBACH TEST ALBRITTON & HERBERT
ROBIN M. SILVA
FOUR EMBARCADERO CENTER
SUITE 3400
SAN FRANCISCO, CA 94111-4187



101618330A

**UNITED STATES PATENT AND TRADEMARK OFFICE
NOTICE OF RECORDATION OF ASSIGNMENT DOCUMENT**

THE ENCLOSED DOCUMENT HAS BEEN RECORDED BY THE ASSIGNMENT DIVISION OF THE U.S. PATENT AND TRADEMARK OFFICE. A COMPLETE MICROFILM COPY IS AVAILABLE AT THE ASSIGNMENT SEARCH ROOM ON THE REEL AND FRAME NUMBER REFERENCED BELOW.

PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT AND TRADEMARK ASSIGNMENT SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR HAVE QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE EMPLOYEE WHOSE NAME APPEARS ON THIS NOTICE AT 703-308-9723. PLEASE SEND REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE, ASSIGNMENT DIVISION, BOX ASSIGNMENTS, CG-4, 1213 JEFFERSON DAVIS HWY, SUITE 320, WASHINGTON, D.C. 20231.

RECORDATION DATE: 02/12/2001

REEL/FRAME: 011517/0330
NUMBER OF PAGES: 9

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:

DAHIYAT, BASSIL I.

DOC DATE: 06/15/2000

ASSIGNOR:

HAYES, ROBERT J.

DOC DATE: 06/16/2000

ASSIGNOR:

BENTZIEN, JORG

DOC DATE: 06/16/2000

ASSIGNOR:

FIEBIG, KLAUS M.

DOC DATE: 06/20/2000

ASSIGNEE:

XENCOR, INC.
111 W. LEMON AVENUE
MONROVIA, CALIFORNIA 91016

SERIAL NUMBER: 09419351

PATENT NUMBER:

FILING DATE: 10/15/1999

ISSUE DATE:

011517/0330 PAGE 2

MARCUS KIRK, EXAMINER
ASSIGNMENT DIVISION
OFFICE OF PUBLIC RECORDS

02-21-2001

FORM PTO-1:
1-31-92

ION FORM COVER SHEET

U.S. DEPARTMENT OF COMMERCE

Patent and Trademark Office

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2-12-01

To the Hon.

101618330

arks. Please record the attached original documents or copy thereof.

1. Name of conveying party(ies):

Bassil I. DAHIYAT; Robert J. HAYES;
Jorg BENTZIEN; Klaus M. FIEBIGAdditional name(s) of conveying
party(ies) attached?☐ Yes ☒ No

3. Nature of Conveyance:

☒ Assignment☐ Merger☐ Security Agreement☐ Change of Name

Execution Date: June 16, 2000 and June 20, 2000

2. Name and address of receiving party(ies):

Internal Address: Xencor, Inc.Street Address: 111 W. Lemon AvenueCity: MonroviaState: CaliforniaZip: 91016

Additional name(s) & address(es) attached?

☐ Yes ☒ No

4. Application number(s) or patent number(s): One (1)

If this document is being filed together with a new application, the execution date of the application is: _____

A. Patent Application No.(s): 09/419,351

B. Patent No.(s)

Additional numbers attached? ☐ Yes ☒ No5. Name and address of party to whom correspondence concerning
document should be mailed:Name: Robin M. SilvaInternal Address: FLEHR HOHBACH TEST
ALBRITTON & HERBERT LLPStreet Address: SUITE 3400FOUR EMBARCADERO CENTERCity: SAN FRANCISCOState: CAZip: 94111-4187

6. Total number of applications and patents involved:

One (1)

7. Total fee (37 CFR 3.41):.....\$40.00☒ Enclosed☐ Authorized to be charged to deposit account8. Deposit account number: 06-1300Please debit any underpayment or credit any overpayment
to the above deposit account.Our Order No. A-67229-2/RFT/RMS/RMK

DO NOT USE THIS SPACE

9. Statement and signature.

*To the best of my knowledge and belief, the foregoing information is true and correct and any attached
copy is a true copy of the original document.*Robin M. Silva

Name of Person Signing

Robin M. Silva

Signature

2/9/01

Date

Total number of pages including cover sheet, attachments and document: [9]

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01 FC:581

40.00 DP

File No. A-67229-2/RFT?RMS/RMK

Rev. 8/93

ASSIGNMENT

(NOT ACCOMPANYING APPLICATION)

WHEREAS, the undersigned,

(1) BASSIL I. DAHIYAT, (2) ROBERT J. HAYES,

(3) JÖRG BENTZIEN, (4) KLAUS M. FIEBIG,

(hereinafter termed "Inventors"), residents of

(1) LOS ANGELES, (2) ALTADENA,

(3) PASADENA, (4) FRANKFURT, GERMANY,

respectively, Counties of

(1) LOS ANGELES, (2) LOS ANGELES,

(3) LOS ANGELES, (4) n/a,

respectively, States of

(1) CALIFORNIA, (2) CALIFORNIA,

(3) CALIFORNIA, (4) n/a,

respectively, have invented certain new and useful improvements in

PROTEIN DESIGN AUTOMATION FOR PROTEIN LIBRARIES

and have executed an application for a United States patent disclosing and identifying the invention on the _____ day of _____, 2000 and having Serial No. 09/419,351 and filing date of October 15, 1999; and

WHEREAS, XENCOR, INC. a corporation of the State of CALIFORNIA, having a place of business at 2585 NINA STREET, PASADENA 91107-3708, State of CALIFORNIA, (hereinafter termed "Assignee"), is desirous of acquiring the entire right, title and interest in and to said application and the invention disclosed therein, and in and to all embodiments of the invention, heretofore conceived, made or discovered jointly or severally by said Inventors (all collectively hereinafter termed "said invention"), and in and to any and all patents, inventor's certificates and other forms of protection (hereinafter termed "patents") thereon granted in the United States and foreign countries.

NOW, THEREFORE, in consideration of good and valuable consideration acknowledged by said Inventors to have been received in full from said Assignee:

1. Said Inventors do hereby sell, assign, transfer and convey unto said Assignee, the entire right, title and interest (a) in and to said application and said invention; (b) in and to all rights to apply for foreign patents on

said invention pursuant to the International Convention for the Protection of Industrial Property or otherwise; (c) in and to any and all applications filed and any and all patents granted on said invention in the United States or any foreign country, including each and every application filed and each and every patent granted on any application which is a division, substitution, or continuation of any of said applications; and (d) in and to each and every reissue or extensions of any of said patents.

2. Said Inventors hereby jointly and severally covenant and agree to cooperate with said Assignee to enable said Assignee to enjoy to the fullest extent the right title and interest herein conveyed in the United States and foreign countries. Such cooperation by said Inventors shall include prompt production of pertinent facts and documents, giving of testimony, execution of petitions, oaths, specifications, declarations or other papers, and other assistance all to the extent deemed necessary or desirable by said Assignee (a) for perfecting in said Assignee the right, title and interest herein conveyed; (b) for prosecuting any of said applications; (c) for filing and prosecuting substitute, divisional, continuing or additional applications covering said invention; (d) for filing and prosecuting applications for reissuance of any said patents; (e) for interference or other priority proceedings involving said invention; and (f) for legal proceedings involving said invention and any applications therefor and any patents granted thereon, including without limitation opposition proceedings, cancellation proceedings, priority contests, public use proceedings, infringement actions and court actions; provided, however, that the expense incurred by said Inventors in providing such cooperation shall be paid for by said Assignee.

3. The terms and covenants of this assignment shall inure to the benefit of said Assignee, its successors, assigns and other legal representatives, and shall be binding upon said Inventors, their respective heirs, legal representatives and assigns.

4. Said Inventors hereby jointly and severally warrant and represent that they have not entered and will not enter into any assignment, contract, or understanding in conflict herewith.

IN WITNESS WHEREOF, the said Inventors have executed and delivered this instrument to said Assignee this

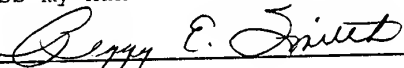
(1) 15 day of June, 2000 (2) 16 day of June, 2000,
(3) 16 day of June, 2000, (4) _____ day of _____, 2000,
respectively.

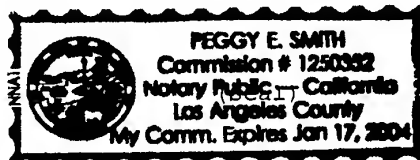
(1) 
BASSIL I. DAHIYAT

County of Los Angeles ,)
State of California) ss.
.)

On this 16th day of June, in the year 2000, before me,
Peggy E. Smith, Notary Public of the State of California,
personally appeared (1) BASSIL I. DAHIYAT, personally known to me (or proved
to me on the basis of satisfactory evidence) to be the person whose name is
subscribed to the within instrument, and acknowledged that he executed the
same in his authorized capacity(ies), and that by his signature on the
instrument the person, or the entity upon behalf of which the person acted,
executed the instrument.

WITNESS my hand and official seal.

Signature 

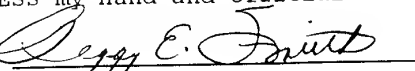


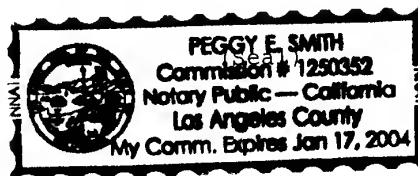
County of Los Angeles ,)
State of California) ss.
.)

(2) 
ROBERT J. HAYES

On this 16th day of June, in the year 2000, before me,
Peggy E. Smith, Notary Public of the State of California,
personally appeared (2) ROBERT J. HAYES, personally known to me (or proved
to me on the basis of satisfactory evidence) to be the person whose name is
subscribed to the within instrument, and acknowledged that he executed the
same in his authorized capacity(ies), and that by his signature on the
instrument the person, or the entity upon behalf of which the person acted,
executed the instrument.

WITNESS my hand and official seal.

Signature 



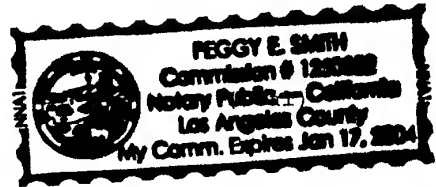
County of Los Angeles
State of California

(3) Jörg Bentzien
JÖRG BENTZIEN
,)
) ss.
)

On this 16th day of June, in the year 2000, before me,
Peggy E. Smith, Notary Public of the State of _____,
personally appeared (3) JÖRG BENTZIEN, personally known to
me (or proved to me on the basis of satisfactory evidence) to be the person
whose name is subscribed to the within instrument, and acknowledged that he
executed the same in his authorized capacity(ies), and that by his
signature on the instrument the person, or the entity upon behalf of which the
person acted, executed the instrument.

WITNESS my hand and official seal.

Signature Peggy E. Smith



(4) _____
KLAUS M. FIEBIG

County of _____,)
) ss.
State of _____.)

On this _____ day of _____, in the year _____, before me,
_____, Notary Public of the State of _____,
personally appeared (4) KLAUS M. FIEBIG, personally known to me (or proved
to me on the basis of satisfactory evidence) to be the person whose name is
subscribed to the within instrument, and acknowledged that he executed the
same in his authorized capacity(ies), and that by his signature on the
instrument the person, or the entity upon behalf of which the person acted,
executed the instrument.

WITNESS my hand and official seal.

Signature _____

(Seal)

ASSIGNMENT

(NOT ACCOMPANYING APPLICATION)

COPY

WHEREAS, the undersigned,

(1) BASSIL I. DAHIYAT, (2) ROBERT J. HAYES,
(3) JÖRG BENTZIEN, (4) KLAUS M. FIEBIG,

(hereinafter termed "Inventors"), residents of

(1) LOS ANGELES, (2) ALTADENA,
(3) PASADENA, (4) FRANKFURT, GERMANY,

respectively, Counties of

(1) LOS ANGELES, (2) LOS ANGELES,
(3) LOS ANGELES, (4) n/a,

respectively, States of

(1) CALIFORNIA, (2) CALIFORNIA,
(3) CALIFORNIA, (4) n/a,

respectively, have invented certain new and useful improvements in

PROTEIN DESIGN AUTOMATION FOR PROTEIN LIBRARIES

and have executed an application for a United States patent disclosing and identifying the invention on the _____ day of _____, 2000 and having Serial No. 09/419,351 and filing date of October 15, 1999; and

WHEREAS, XENCOR, INC. a corporation of the State of CALIFORNIA, having a place of business at 2585 NINA STREET, PASADENA 91107-3708, State of CALIFORNIA, (hereinafter termed "Assignee"), is desirous of acquiring the entire right, title and interest in and to said application and the invention disclosed therein, and in and to all embodiments of the invention, heretofore conceived, made or discovered jointly or severally by said Inventors (all collectively hereinafter termed "said invention"), and in and to any and all patents, inventor's certificates and other forms of protection (hereinafter termed "patents") thereon granted in the United States and foreign countries.

NOW, THEREFORE, in consideration of good and valuable consideration acknowledged by said Inventors to have been received in full from said Assignee:

1. Said Inventors do hereby sell, assign, transfer and convey unto said Assignee, the entire right, title and interest (a) in and to said application and said invention; (b) in and to all rights to apply for foreign patents on

said invention pursuant to the International Convention for the Protection of Industrial Property or otherwise; (c) in and to any and all applications filed and any and all patents granted on said invention in the United States or any foreign country, including each and every application filed and each and every patent granted on any application which is a division, substitution, or continuation of any of said applications; and (d) in and to each and every reissue or extensions of any of said patents.

2. Said Inventors hereby jointly and severally covenant and agree to cooperate with said Assignee to enable said Assignee to enjoy to the fullest extent the right title and interest herein conveyed in the United States and foreign countries. Such cooperation by said Inventors shall include prompt production of pertinent facts and documents, giving of testimony, execution of petitions, oaths, specifications, declarations or other papers, and other assistance all to the extent deemed necessary or desirable by said Assignee (a) for perfecting in said Assignee the right, title and interest herein conveyed; (b) for prosecuting any of said applications; (c) for filing and prosecuting substitute, divisional, continuing or additional applications covering said invention; (d) for filing and prosecuting applications for reissuance of any said patents; (e) for interference or other priority proceedings involving said invention; and (f) for legal proceedings involving said invention and any applications therefor and any patents granted thereon, including without limitation opposition proceedings, cancellation proceedings, priority contests, public use proceedings, infringement actions and court actions; provided, however, that the expense incurred by said Inventors in providing such cooperation shall be paid for by said Assignee.

3. The terms and covenants of this assignment shall inure to the benefit of said Assignee, its successors, assigns and other legal representatives, and shall be binding upon said Inventors, their respective heirs, legal representatives and assigns.

4. Said Inventors hereby jointly and severally warrant and represent that they have not entered and will not enter into any assignment, contract, or understanding in conflict herewith.

(1) 15 day of June, 2000 (2) _____ day of _____, 2000,
(3) _____ day of _____, 2000, (4) 20 day of June, 2000,
respectively.

County of _____,)
) ss.
 State of _____.)

Signature _____ (Seal)

County of _____,)
) ss.
 State of _____.)

Signature _____ (Seal)

JÖRG BENTZIEN

County of

.) SS.

State of

On this _____ day of _____, in the year _____, before me, _____, Notary Public of the State of _____, personally appeared (3) JÖRG BENTZIEN, personally known to me (or proved to me on the basis of satisfactory evidence) to be the person whose name is subscribed to the within instrument, and acknowledged that he executed the same in his authorized capacity(ies), and that by his signature on the instrument the person, or the entity upon behalf of which the person acted, executed the instrument.

WITNESS my hand and official seal.

Signature _____

(Seal)

(4)

KLAUS M. / FIEBIG

County of

,)
) SS.
 .)

State of

On this _____ day of _____, in the year _____, before me, _____, Notary Public of the State of _____, personally appeared (4) KLAUS M. FIEBIG, personally known to me (or proved to me on the basis of satisfactory evidence) to be the person whose name is subscribed to the within instrument, and acknowledged that he executed the same in his authorized capacity(ies), and that by his signature on the instrument the person, or the entity upon behalf of which the person acted, executed the instrument.

WITNESS my hand and official seal.

Signature _____

(Seal)